

REMARKS***Explanation of Amendments Made***

Although it is believed that the inclusion of stearic acid in claim 5 does not render the claims to be obvious in light of the prior art cited, stearic acid is being deleted to narrow the issues under consideration for appeal. As the grouping of emulsifier A was limited to only nine specific emulsifiers, applicants presume that a thorough search of the invention as directed by MPEP 904 et seq. was conducted by the Examiner and that deletion of the term should raise no new considerations.

Claims 5, 7-11 and 16-19 remain pending. It is believed that no new matter has been added.

Prior Art Rejections

- (1) Claims 5 and 7-11 were rejected as being anticipated by Thomas et al. (U.S. Patent 5,610,130);
- (2) Claims 16 and 17 were rejected as being obvious over Thomas et al., *id.*, in view of Moore et al. (U.S. Patent 6,063,746);
- (3) Claims 18 and 19 were rejected as being obvious over Thomas et al. and Moore et al., *id.*, further in view of Klier et al. (U.S. Patent 4,127,672). The applicants previously conceded that for the present invention these claims stand or fall with the rejection of claims 16 and 17.

The applicants maintain the positions previously presented but respectfully request reconsideration of the above rejections in light of the applicants' rebuttal to the Examiner's "Response to Arguments" below.

The Examiner's response indicates that the phrase "consisting essentially of" is being accorded the same weight as the term "comprising" for the purposes of her examination. Accepting this as fact, even if the term "comprising" may allow for the inclusion of additional elements even in large amounts (see MPEP 2111.03), this is only a preliminary determination, i.e. use of the term "comprising" does not absolve the Examiner from applying the required standards for establishing anticipation (MPEP 2131 et seq.) or obviousness (MPEP 2141 et seq.). It is only after applying these standards that one can determine that "comprising" actually does allow for the inclusion of additional elements.

The applicants hold that in the present application, the emulsifiers used in the applicants' claimed invention are not taught or suggested by the prior art and in fact the Examiner's primary reference actually teaches away from using the applicants claimed emulsifiers.

The Examiner's anticipation rejection appears to be based on the possible inclusion of stearic acid in Thomas et al.'s emulsion. While the applicants do not agree with this position, this argument has been rendered moot by the deletion of the term "stearic acid" from the claims.

The rejection of claims 16 and 17 appear to be predicated on being able to exchange emulsifiers as needed, i.e. a reference was produced which contained the claimed emulsifiers (Moore et al.) and the Examiner stated that it would have been obvious to substitute the emulsifiers used in Thomas et al. with the emulsifiers used in Moore et al. Besides the standard *In re Rouffet*-response¹, the applicants also present that the Thomas et al. reference teaches away from making such a random substitution.

Thomas et al. describes the problem associated with microemulsions prior to their invention, i.e. microemulsions were too hydrophobic to allow for the inclusion of insect repellent materials (see col. 4, lines 34-38). Thomas et al. solves this problem by adjusting the composition in "...one or more of the following ways:

- (1) by lowering the amount of multivalent cation, typically magnesium ion, in the composition relative to the anionic surfactant;
- (2) by selecting a more hydrophilic anionic surfactant; and
- (3) by utilizing a higher ratio of anionic surfactant to the ethoxylated glycerol-based non-ionic surfactant mixture." (see col. 4, lines 51-64)

There is no indication in Thomas et al. that one of ordinary skill in the art could ignore their specific limitations and substitute an alternative emulsifier to obtain an oil-in-water emulsion which is able to accommodate an insect repellent.

In addition, although the applicants claims use the phrase "consisting essentially of" (read to be equivalent as "comprising" by the Examiner), the scope of the emulsifiers used is limited by specific definition (i.e. emulsifier A is limited by the "selected from the group consisting of" language) or by the type of emulsifier (i.e. optional inclusion of a water-in-oil emulsifier for an oil-in-water emulsion - Thomas et al. does not teach or suggest this limitation) and as such there is no potential overlap with Thomas et al.'s

¹ "As this court has stated, 'virtually all [inventions] are combinations of old elements...Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.' *Sensotronics, Inc. v. Aerisonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).'" *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1450, 1457, (Fed. Cir. 1998).

invention. When combined with the rigid requirements for selection of an emulsifier set forth by Thomas et al., one of ordinary skill in the art would not substitute the emulsifiers taught in Moore et al. (or any other reference) into the emulsion of Thomas et al.

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

Norris, McLaughlin & Marcus, P.A.

By: Howard C. Lee

Howard C. Lee

Reg. No. 48,104

220 East 42nd Street
30th Floor
New York, New York 10017
(212) 808-0700

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 (6 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 16 June 2004

By: Agata Glinska
Agata Glinska